

REMARKS***Foreign Priority***

Applicants note that the Office Action Summary accompanying the Office Action of February 23, 2006 did not acknowledge Applicants' priority claim to Japanese Application No. 2002-287768. Applicants note that a claim of priority to Japanese Application No. 2002-287768 was filed along with a certified copy of the priority document on December 3, 2003. Therefore, Applicants respectfully request that the Examiner acknowledge Applicants' claim to priority in the next communication from the Office.

Information Disclosure Statement

Applicants thank the Examiner for consideration of the Information Disclosure Statements filed March 12, 2004 and August 22, 2005, and return of the initialed Forms PTO-1449. Applicants also thank the Examiner for consideration of the documents submitted with the Information Disclosure Statement filed September 16, 2005.

Summary of the Amendment

Upon entry of the foregoing amendment, claims 1 and 3 are amended, and claims 10 and 11 are added, whereby claims 1-11 currently remain pending. Claim 1 has been amended only to remove "step" language. Support for new claim 10 can be found in Applicants' originally filed claim 10 which was removed

upon submission of the Substitute Specification in favor of claim 3 which was multiple dependent. Thus, Applicants have amended claim 3 and added claim 10 to correspond to the claims as originally filed. Support for new claim 11 can be found throughout Applicants' specification, is inherent therein, including for example, FIG. 4; page 3, lines 3-6; and page 17, line 19 to page 18, line 7. Applicants submit that no new matter has been added.

Summary of Rejections in the Office Action

In the instant Office Action, claims 1-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 4,944,817 (hereinafter, "BOURELL"). The Office Action states that BOURELL discloses the invention substantially as claimed, and BOURELL discloses an embodiment wherein the additional layers are of materials different from the first powder layer, inherently resulting in at least one of the additional layers having a density different than the first powder layer. The Office Action further states that BOURELL discloses that the layer may comprise copper or iron group metals. The Office Action points to col. 2, lines 47-60; col. 4, lines 3-12; col. 6, lines 30-66; col. 7, lines 20-23; and col. 7, lines 8-19 for the general teachings of claims 1 and 9 of the present invention.

Arguments

By the present amendment and remarks, Applicants submit that it is clear that the rejections should be withdrawn, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application. Specific arguments in response to the rejection recited in the Office action is set forth below.

1. The rejection of claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over BOURELL.

Applicants respectfully request withdrawal of the rejection of claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over BOURELL in view of the following remarks.

It is well settled that in order to properly establish a *prima facie* case of obviousness, assuming, *arguendo*, that the rejection is based on a proper combination, the combined teachings must disclose all of the recitations of the rejected claims and the cited document(s) must contain some suggestion or motivation for such combination. Applicants respectfully submit that the obviousness rejection using the **single** reference of BOURELL does not disclose or suggest all of the recitations of claims 1-9. However, as will be shown below, even assuming, *arguendo*, that the application of BOURELL against the claims is proper, BOURELL still fails to establish a *prima facie* case of obviousness for at least the following reasons:

Applicant notes numerous differences between BOURELL and the presently claimed invention. The Office Action asserts that the additional layers are of materials different from the first powder layer, and that such layers would inherently have different properties. However, Applicants respectfully submit that nothing in BOURELL teaches or suggests at least the recitation of a “second lower density layer is formed on the first higher density layer” as presently claimed. Therefore, Applicants respectfully submit that a proper *prima facie* case of obviousness has not been established because the Office Action does not provide a basis as to why one having ordinary skill in the art would modify BOURELL to arrive at the present claims.

Moreover, Applicants respectfully submit that the statement in the Office Action that the additional layers of BOURELL would inherently have a different density from the first layer because they are made from different materials is facially incorrect. Applicants’ claimed recitation of “second lower density layer is formed on the first higher density layer” can be obtained by at least adjusting the sintering conditions, namely (1) laser power, (2) laser spot diameter, and (3) scanning speed (see, e.g., FIG. 7C and p. 13, lines 15-21 of Applicants’ specification) even when using the same materials for all the layers, features not disclosed or suggested by BOURELL. Applicants’ claimed feature of a “second lower density layer is formed on the first higher density layer” also provides at least the property of good adherence between the lower density second layer and the higher density first layer. Thus, by controlling the “sintering condition,” layer

density can be varied between different layers, even if the layers are formed from the same material, features not disclosed or suggested by BOURELL.

In addition to the differences between BOURELL and the present claims as noted above, BOURELL discloses that the additional layers are of materials different from said first powder layer. However, Applicants note that newly added claim 11 specifically recites the feature wherein the plurality of first and second layers are made from the same material. Thus, Applicants respectfully submit that newly added claim 11 is also patentable over BOURELL.

Regarding dependent claims 2-9, the Office Action asserts that the powder of BOURELL can be a blend of materials with different bonding or dissociation temperatures (col. 6, lines 14-44). However, Applicant respectfully submits that dependent claims 2-9 (and new claims 10-11) are clearly patentable because they include features of independent claim 1, which is also patentable for at least the reason that BOURELL does not teach or suggest the recitation of a “second lower density layer is formed on the first higher density layer.”

Therefore, in view of at least the foregoing remarks, BOURELL fails to establish a *prima facie* case of obviousness as to why one would modify BOURELL to arrive at the present claims. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejection of claims 1-9.

Application is Allowable

Thus, Applicants respectfully submit that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. § 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

Authorization to Charge Deposit Account

If for any reason the necessary fees are not associated with this file, the undersigned authorizes the charging of any necessary fees not explicitly identified, to Deposit Account No. 19-0089 in order to maintain pendency of this application.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipates or renders obvious the Applicants' invention, as recited in each of claims 1-11. In addition, the applied documents of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
Satoshi ABE et al.

A handwritten signature in black ink, appearing to read "Bruce H. Bernstein", written over a horizontal line.

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